

Application No. 10/820,644

REMARKS

Claims 1-12 are pending. By this Amendment, claim 13 is added. No new matter is introduced in this Amendment.

35 U.S.C § 103 Rejections

Claims 1-3 and 8-10 are rejected under 35 U.S.C. § 103(a) over Sellgren et al., U.S. Patent No. 6,420,682, in view of Faloon et al., U.S. Patent No. 5,575,552. Claims 11 and 12 are also rejected under 35 U.S.C. § 103(a) over Sellgren in view of Faloon and Gorischek, U.S. Patent Application Publication No. 2002/0196333. These rejections are respectfully traversed based upon the comments set forth below.

In the absence of an express motivation to combine references, care must be taken to avoid impermissible hindsight in establishing the obviousness of a combination.¹ The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.²

Accordingly, the combination of Sellgren in view of Faloon does not establish a *prima facie* case of obviousness as to the base claim 1 because the references do not suggest, expressly or implicitly, the desirability of combining the lighting feature of Faloon with the heated mirror of Sellgren. Rather, the suggestion to combine is provided only by the hindsight afforded by Applicants' invention. Such a basis for the rejection is not appropriate. Claims 2, 3 and 8-12, which depend from claim 1, are likewise traversed.

¹ *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004).

² *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (reversing an obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention).

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Likewise, Applicants respectfully submit that combining Sellgren and Faloon in further view of Gorischek lacks sufficiency for a *prima facie* case of obviousness against claims 11 and 12 because the references, individually or together, do not suggest the desirability of combining the heated mirror of Sellgren and the lighting feature of Faloon with the touch type controls and associated technologies of Gorischek.

Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) over Sellgren in view of Faloon and in further view of Jones et al., U.S. Patent No. 6,512,203. These rejections are respectfully traversed.

The combination of the Sellgren, Faloon and Jones references does not establish a *prima facie* case of obviousness as to claims 4 and 5 because, as discussed above, there is no *prima facie* case of obviousness as to claim 1, from which both claims 4 and 5 depend. Furthermore, Applicants respectfully point out that the mere substitution of one type of device for another in the system of the primary reference (as in substituting a resistor or a polymer thick film heater for a heater element) does not support an obviousness rejection.³

In summary, Applicants respectfully request that the rejection of claims 1-5 and 8-12 under 35 U.S.C. § 103(a) be withdrawn.

Allowable Subject Matter

Claims 6 and 7 are objected to as being dependent on a rejected base claim. Applicants acknowledge and appreciate that claims 6 and 7 stand allowable if rewritten in independent form with all the limitations of the base and any intervening claims. Nevertheless, Applicants

³ *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

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respectfully traverse the objection in view of the discussion above supporting withdrawal of the rejection to claim 1, from which claims 6 and 7 depend.

Accordingly, Applicants respectfully request that the objection to claims 6 and 7 be withdrawn.

Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,


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